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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/559,204	04/26/2000	DAVID REGAN	AND1P578	1516
29838	7590	05/18/2005	EXAMINER	
OPPENHEIMER WOLFF & DONNELLY, LLP (ACCENTURE) PLAZA VII, SUITE 3300 45 SOUTH SEVENTH STREET MINNEAPOLIS, MN 55402-1609			BLACKWELL, JAMES H	
			ART UNIT	PAPER NUMBER
			2176	

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/559,204		REGAN, DAVID	
	Examiner		Art Unit	
	James H. Blackwell		2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 April 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

[Handwritten signature]

DETAILED ACTION

This Office Action is in response to amendment received 01/05/2005.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The claimed invention is directed to non-statutory subject matter. Claims 11-15 are rejected under 35 U.S.C. 101 because it is directed to non-statutory subject matter. Independent Claim 11 is a computer program per se, and is not tangibly embodied on a computer readable medium. Dependent Claims 12-15 are also non-statutory as they fail to correct the problem with Claim 11.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller (U.S. Patent No. 6,202,052) in view of Hunkins et al. (hereinafter Hunkins, U.S. Patent No. 5,970,501) and in further view of TurboTax (TurboTax User's Guide, Version 95.0 tax Year 1995, Intuit).

In regard to independent Claim 1 (and similarly independent Claims 6, and 11), Miller teaches (a) *accessing tax-related forms in a governmentally maintained forms database, wherein the tax-related forms include a plurality of fields* in that an "electronic intermediary" searches for taxpayers tax data (Col. 4, lines 54-56).

Miller fails to disclose (b) ... *the revenue services database stores tax return data in duplicate, in a first table on the revenue services database and in a second table on the revenue services database* and (c) ... *extracting a portion of the tax return data from the revenue services database, such that the extracted tax return data is provided to a legacy processing system from the first table and the extracted tax return data is provided to a corporate information database from the second table.*

However, Hunkins teaches that a large organization (such as the IRS) typically has a number of systems with databases of information for different purposes. Typically these databases contain redundant (duplicate) data. A familiar example is the multiple forms a new employee is typically asked to fill out, for things such as payroll, tax, insurance, phone listing, and perhaps things such as parking permits. Although each form is for a different purpose, the person is asked for some of the same data such as name, address and Social Security number for each form. Each form eventually is input into a computer system, thus leading to the creation and maintenance of multiple databases, which have some common, redundant information (Col. 1, lines 19-30). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Miller and Hunkins because Hunkins contemplates storing data in duplicate both within a single database, and between multiple databases in an

organization. The benefit would have been to maintain multiple copies of critical information.

Moreover, it is notoriously well known in the art to have data in duplicate tables exist in one or more databases either on the same or different machines to decrease the load on any one database/machine, to maintain backups of information, to allow for one machine to be taken offline for maintenance, etc. Incidentally, Miller does teach that portions of the tax data come from several existing (legacy) systems (see Fig. 2).

Miller does not specifically teach *(d) completing at least one of the tax-related forms, wherein a first set of fields from the plurality of fields are filled based on the tax return data, wherein the tax return data on which field filling is based is extracted from both the legacy processing system and a succeeding processing system, wherein a second set of fields from the plurality of fields is populated based on data entered into a first set of fields, and wherein the revenue services database mirrors data tables on the succeeding processing system.*

However, Hunkins teaches (referring to Fig. 3) a single change order (20) to administration, to change the employee name, only requires one update to a computer (50) having the centralized or common database (70) (*a succeeding processing system*). This computer then performs automatic update and synchronization of all four (or more, if others are present) external databases 11-14 (*mirroring*). This is shown in greater detail in Fig. 4, wherein the name fields of the various data files are exploded out to show the common data base contains all the names as indicated at (71), and information to link this information to the corresponding name fields in the external data

files, in a way that the computer can change and update them all (Col. 5, lines 5-20). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Miller and Hunkins because both relate to organizations that access multiple databases likely containing some duplicate data. Adding the teaching of Hunkins allows for incorporating a new system that consolidates the data in once place, yet allows updates to be passed along to legacy systems (actually, Miller suggests in Fig. 2 that the connections between the central and other database sites are 2-way allowing for the possibility of such interactions as taught by Hunkins).

Continuing, Miller teaches *(e) submitting the tax-related forms to a government entity, wherein the tax-related forms are formatted based on rules associated with the governmental entity* in that the electronic intermediary electronically files the processed tax returns with the taxing authorities which, in the case of the U.S. Internal Revenue Service (IRS), will correspond to the appropriate federal tax return such as the Form 1040 or the Form 1040EZ (note both forms contain content and structure that are produced, maintained, and updated by the IRS) (Col. 6, lines 56-61; 62-64).

Miller fails to explicitly teach *(f) sending updates to the tax-related forms to a processor utilizing a network for processing and subsequent use*. However, TurboTax teaches electronic filing of updated (with tax information from user) tax forms with the IRS via a modem using the provided communications software to send the returns to TurboTax's electronic filing center (pp. 70-79). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Miller and

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TurboTax as both inventions relate to the preparation of taxes. Adding the teaching of TurboTax provides the benefit of electronic filing.

Miller fails to specifically teach *(g) displaying an activities interface to the user, wherein the activities interface identifies activities for users to complete, and governs the data collection process for completing the identified activities*. However, TurboTax teaches a tax interview called EasyStep that prompts a user for information that eventually leads to tax forms being filled out with the information that is collected from the user (pp. 13-15). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Miller and TurboTax as both inventions relate to the preparation of taxes. Adding the teaching of TurboTax provides the benefit of a foolproof way to do your taxes.

In regard to dependent Claim 2 (and similarly dependent Claims 7, and 12), Miller teaches *storing updates to the tax-related forms in the governmentally maintained forms database* in that the "electronic intermediary" receives data from the taxpayer's brokerage firms, taxpayer's charities, taxpayer's other tax data providers, taxing authorities, taxpayer's banks, taxpayer's employers which can be stored by the electronic intermediary (Col. 5, lines 50-65; Fig. 2).

In regard to dependent Claim 3 (and similarly dependent Claims 8, and 13), Miller teaches *submitting the completed tax-related forms to a processor utilizing a network for processing* in that the electronic intermediary electronically files the tax returns with the taxing authorities (Col. 6, lines 62-64).

In regard to dependent Claim 4 (and similarly dependent Claims 9, and 14), Miller teaches *the processed tax-related forms are received utilizing the network for storage in the governmentally maintained forms database* in that the electronic intermediary can receive processed data from any of the entities (see Fig. 2).

In regard to dependent Claim 5 (and similarly dependent Claims 10, and 15), Miller teaches that *the network is the Internet* in that an electronic data network such as the Internet is used by the electronic intermediary (Col. 3; lines 60-65; Col. 4, lines 51-54).

Response to Arguments

Applicant's arguments with respect to Claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any


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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Blackwell whose telephone number is 571-272-4089. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on 571-272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER

James H. Blackwell
05/11/05